UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,306	06/23/2000	Brian Wolfe	5053-36200	1775

7590 05/27/2004

Eric B Meyertons
Meyertons Hood Kivlin Kowert & Goetzel P C
PO Box 398
Austin, TX 78767-0398

EXAMINER	
PASS, NATALIE	

ART UNIT	PAPER NUMBER
3626	18

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/603,306	WOLFE, BRIAN	
	Examiner	Art Unit	
	Natalie A. Pass	3626	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2004 and 15 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-25,27-39,41-51 and 53-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-25,27-39,41-51 and 53-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *14 and 16*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 January 2004 has been entered.

2. This communication is in response to the Request for Continued Examination filed 16 January 2004 and the amendments filed 16 January 2004 and 15 March 2004. Claims 1, 17, 31 and 47 have been amended. Claims 10, 26, 40 and 52 have been cancelled. Claims 57-59 have been previously presented. Claims 1-9, 11-25, 27-39, 41-51, 53-59 remain pending.

Information Disclosure Statement

3. The information disclosure statement filed 3 February 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

4. The IDS statement filed 5 February 2004 has been entered and considered.

Specification

5. The amendments filed 16 January 2004 and 15 March 2004 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc. The added material which is not supported by the original disclosure is as follows:

- "retrieving the matching entry ... without interrupting execution of the insurance claims processing program" as disclosed in claim 57, lines 1-3.

In particular, Applicant does not point to, nor was the Examiner able to find, any support for this newly added language within the specification as originally filed on 23 June 2000. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 23 June 2000.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Newly amended claim 57 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Dependent claim 57 recites limitations that are new matter, as discussed above, and is therefore rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the m3anner in which the invention was made.

10. Claims 1-4, 9, 14, 16-20, 25, 30-34, 39, 44, 46-49, 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of

Kuwamoto et al, U.S. Patent Number 5, 483, 632 and further in view of Abbruzzese, U.S. Patent Number 5, 557, 515.

(A) Claim 1 has been amended to recite the limitations "and estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program" in lines 13-15.

As per newly amended claim 1, Huffman teaches a method comprising:

an insurance claims processing program generating a request to display a message wherein the message text is configured to assist a user in processing an insurance claim using the insurance claims processing program (Huffman; Figures 6, 7, 11, column 2, lines 44-65, column 3, lines 39-41, column 6, lines 26-31, column 7, lines 15-24, 38-44, column 10, lines 41-49, column 11, lines 46-49, column 12, lines 50-53).

Huffamn fails to explicitly disclose:

wherein the request comprises a requested message code or identifier;

searching a database for a matching entry which matches the requested message code, wherein the database stores a plurality of entries including the matching entry, wherein each entry in the database comprises a message code and a corresponding message text;

retrieving the matching entry from the database in response to said searching the database for the matching entry which matches the requested message code, wherein the matching entry comprises a matching message text; and

displaying the matching message text corresponding to the requested message code.

However, the above features are well-known in the art, as evidenced by Kuwamoto.

In particular, Kuwamoto teaches

wherein the request comprises a requested message code or identifier (Kuwamoto; Figure 5, Item 503, column 2, lines 32-34, 45-48);

searching a database for a matching entry which matches the requested message code, wherein the database stores a plurality of entries including the matching entry, wherein each entry in the database comprises a message code and a corresponding message text (Kuwamoto; Figure 5, Figure 7, column 2, lines 49-59, column 5, lines 49-59, column 6, lines 5-8);

retrieving the matching entry from the database in response to said searching the database for the matching entry which matches the requested message code, wherein the matching entry comprises a matching message text (Kuwamoto; Abstract, column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16); and

displaying the matching message text corresponding to the requested message code (Kuwamoto; column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Huffman to include wherein the request comprises a requested message code or identifier; searching a database for a matching entry which matches the requested message code, wherein the database stores a plurality of entries including the matching entry, wherein each entry in the database comprises a message code and a corresponding message text; retrieving the matching entry from the database in response to said searching the database for the matching entry which matches the requested message code, wherein the matching entry comprises a matching message text; and displaying the matching

message text corresponding to the requested message code, as taught by Kuwamoto, with the motivation of providing a method and a system of help-information control whereby the help facility is implemented so that the processing overhead on application programs is minimized, with the contents of help messages for display being readily modified in accordance with any changes in or additions to application program functions (Kuwamoto; column 2, lines 9-16).

Huffman fails to explicitly disclose estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program.

However, the above features are well-known in the art, as evidenced by Abbruzzese.

In particular, Abbruzzese teaches

estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program wherein the insurance claim comprises a bodily injury claim (Abbruzzese; column 24, line 52 to column 26, line 18, Tables XII and XVI (columns 27-28 and 31 respectively), column 43, lines 45-49, column 138, lines 55-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Huffman and Kuwamoto to include wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value, as taught by Abbruzzese, with the motivation of minimizing the time to prepare and complete all insurance forms, letters, reports and checks in processing insurance claims, reducing or eliminating paper in the maintenance of records in processing work, electronically

capturing all physical documentation for the processing of claims, enabling them to be readily stored and retrieved, electronically associating substantiating documentation with all payment transactions undertaken through a computerized work management system enabling them to be readily stored and retrieved (Abbruzzese; column 2, lines 35-46).

(B) Claim 17 differs from claim 1 in that it is a system rather than a method.

Claim 17 has been amended to recite the limitations "and estimate a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program" in lines 19-22.

As per newly amended claim 17, Huffman, Kuwamoto, and Abbruzzese teach a system comprising:

a CPU (Huffman; Figure 2, column 4, lines 28-64);

a memory coupled to the CPU, wherein the memory stores an insurance claims processing program which is executable by the CPU (Huffman; Figure 2, column 4, lines 28-64);

a display device coupled to the CPU (Huffman; Figure 2, column 4, lines 28-64);

a database coupled to the CPU, wherein the database stores a plurality of entries, wherein each entry in the database comprises a message code and a corresponding message text (Huffman; column 11, lines 62-67), (Kuwamoto; Figure 5, Figure 7, column 2, lines 49-59, column 5, lines 49-59, column 6, lines 5-8);

wherein the memory stores program instructions which are executable by the CPU to:

generate a request to display a message, wherein the request comprises a requested message code (Kuwamoto; Figure 5, Item 503, column 2, lines 32-34, 45-48);

search the database for a matching entry which matches the requested message code (Kuwamoto; Figure 5, Figure 7, column 2, lines 49-59, column 5, lines 49-59, column 6, lines 5-8);

retrieve the matching entry from the database, wherein the matching entry comprises a matching message text (Kuwamoto; Abstract, column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16); and

display the matching message text corresponding to the requested message code on the display device or display unit, (Kuwamoto; Figure 2, Item 117, column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16) wherein the message text is configured to assist a user in processing an insurance claim using the insurance claims processing program (Huffman; Figures 6, 7, 11, column 2, lines 44-65, column 3, lines 39-41, column 6, lines 26-31, column 7, lines 15-24, 38-44, column 10, lines 41-49, column 11, lines 46-49, column 12, lines 50-53); and

estimate a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program wherein the insurance claim comprises a bodily injury claim (Abbruzzese; column 24, line 52 to column 26, line 18, Tables XII and XVI (columns 27-28 and 31 respectively), column 43, lines 45-49, column 138, lines 55-58).

The motivations for combining the respective teachings of Huffman, Kuwamoto, and Abbruzzese are as given in the rejection of claim 1 above, and incorporated hererein.

(C) Claim 31 differs from claims 1 and 17 in that it is a carrier medium comprising program instructions rather than a method or a system.

Claim 31 has been amended to recite the limitations "and estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program" in lines 14-16.

As per newly amended claim 31, Huffman, Kuwamoto, and Abbruzzese teach a carrier medium comprising program instructions, wherein the program instructions are executable by a computer system (Huffman; Figure 2, column 4, lines 28-64) to implement a method of:

generating a request to display a message, wherein the request comprises a requested message code (Kuwamoto; Figure 5, Item 503, column 2, lines 32-34, 45-48);

searching a database for a matching entry which matches the requested message code, wherein the database stores a plurality of entries including the matching entry, wherein each entry in the database comprises a message code and a corresponding message text (Kuwamoto; Figure 5, Figure 7, column 2, lines 49-59, column 5, lines 49-59, column 6, lines 5-8);

retrieving the matching entry from the database in response to said searching the database for the matching entry which matches the requested message code, wherein the matching entry comprises a matching message text (Kuwamoto; Abstract, column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16); and

displaying the matching message text corresponding to the requested message code, (Kuwamoto; Figure 2, Item 117, column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16) wherein the message text is configured to assist a user in processing an insurance claim using an insurance claims processing program (Huffman; Figures 6, 7, 11,

column 2, lines 44-65, column 3, lines 39-41, column 6, lines 26-31, column 7, lines 15-24, 38-44, column 10, lines 41-49, column 11, lines 46-49, column 12, lines 50-53); and

estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program wherein the insurance claim comprises a bodily injury claim (Abbruzzese; column 24, line 52 to column 26, line 18, Tables XII and XVI (columns 27-28 and 31 respectively), column 43, lines 45-49, column 138, lines 55-58).

The motivations for combining the respective teachings of Huffman, Kuwamoto, and Abbruzzese are as given in the rejection of claim 1 above, and incorporated herein.

(D) Claim 47 differs from claims 1 and 17 and 31 in that it is a method comprising installing software which generates, searches, retrieves and displays message information rather than a method of generating, searching, retrieving and displaying message information or a system or a carrier medium.

Claim 47 has been amended to recite the limitations "and estimate a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program" in lines 20-22.

As per newly amended claim 47, Huffman, Kuwamoto, and Abbruzzese teach a method comprising:

installing an insurance claims processing program on at least one of a plurality of computer systems operated by an insurance organization (Huffman; Figure 2, column 4, lines 28-64), wherein the insurance claims processing program is configured to assist a user employed by

the insurance organization in processing insurance claims (Huffman; Figures 6, 7, 11, column 2, lines 44-65, column 3, lines 39-41, column 6, lines 26-31, column 7, lines 15-24, 38-44, column 10, lines 41-49, column 11, lines 46-49, column 12, lines 50-53); and

installing a message database or message table on at least one of the plurality of computer systems operated by the insurance organization, wherein the message database or message table comprises a plurality of entries, wherein each entry comprises a message code and a corresponding message text (Kuwamoto; Figure 5, Figure 7, column 2, lines 49-59, column 5, lines 49-59, column 6, lines 5-8), and wherein the messages are configured to assist the user in said processing the insurance claims using the insurance claims processing program (Huffman; Figures 6, 7, 11, column 2, lines 44-65, column 3, lines 39-41, column 6, lines 26-31, column 7, lines 15-24, 38-44, column 10, lines 41-49, column 11, lines 46-49, column 12, lines 50-53);

wherein the insurance claims processing program is configured to:

generate a request to display a message, wherein the request comprises a requested message code (Kuwamoto; Figure 5, Item 503, column 2, lines 32-34, 45-48);

search the message database for a matching entry which matches the requested message code (Kuwamoto; Figure 5, Figure 7, column 2, lines 49-59, column 5, lines 49-59, column 6, lines 5-8);

retrieve the matching entry from the message database, wherein the matching entry comprises a matching message text (Kuwamoto; Abstract, column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16);

display the matching message text on a display device coupled to at least one of the plurality of computer systems (Kuwamoto; Figure 2, Item 117, column 2, line 60 to column 3, line 24, column 6, line 56 to column 7, line 16); and

estimate a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program wherein the insurance claim comprises a bodily injury claim (Abbruzzese; column 24, line 52 to column 26, line 18, Tables XII and XVI (columns 27-28 and 31 respectively), column 43, lines 45-49, column 138, lines 55-58).

The motivations for combining the respective teachings of Huffman, Kuwamoto, and Abbruzzese are as given in the rejection of claim 1 above, and incorporated herein.

(E) As per claims 2-4, 18-20, 32-34, 48-49 Huffman, Kuwamoto, and Abbruzzese teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 above, further comprising:

specifying the message text of each entry in the database during an installation or initialization of the insurance claims processing program or application on a computer system (Kuwamoto; Figure 4, Figure 5, column 3, lines 29-54, column 5, lines 30-47, column 8, lines 56-60) and specifying the message text of each entry in the database during an installation or initialization of the database or application on a computer system (Kuwamoto; Figure 4, Figure 5, Figure 10, column 3, lines 29-54, column 5, lines 30-47, column 8, lines 28-42, 56-60) and further comprising updating the message text of each entry in the database by re-installing the database on the computer system without re-installing the insurance claims processing program

or application on the computer system (Kuwamoto; Figure 14, see at least Item 1431, column 9, lines 45-67, column 10, lines 25-67).

(F) As per claims 9, 16, 25, 30, 39, 46, 56, 57-58, Huffman, Kuwamoto, and Abbruzzese teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 above, wherein each message code comprises a message section and a message code identifier (Kuwamoto; Figure 5, Item 503, Figure 7, column 2, lines 32-34, 45-59, column 5, lines 49-59, column 6, lines 5-8), and wherein each message code comprises a sequence of alphanumeric values (reads on address), wherein each sequence is unique relative to the other sequences (Kuwamoto; Figure 5, Item 503, column 11, lines 59-57);

further comprising retrieving the matching entry which matches the requested message code without interrupting execution of the insurance claims processing program (Kuwamoto; column 7, lines 49-61, column 9, lines 7-24); and

wherein the matching message text or error message warns a user of the insurance claims processing program of an out of range input value (Abbruzzese; column 15, line 61 to column 16, line 9).

(G) As per claims 14, 44, Huffman, Kuwamoto and Abbruzzese teach a method and carrier medium as analyzed and disclosed in claims 1 and 31 above, wherein said displaying the matching message text corresponding to the requested message code comprises the insurance claims processing program displaying the matching message text corresponding to the requested message code (Abbruzzese; column 137, lines 48-49).

11. Claims 5, 11-13, 15, 21, 27-29, 35, 41-43, 45, 50, 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, as applied to claims 1, 17, 31 and 47 above, and further in view of Ertel, U.S. Patent Number 5, 307, 262.

(A) As per claims 5, 21, 35, 50 Huffman, Kuwamoto, and Abbruzzese teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 above.

Huffman, Kuwamoto, and Abbruzzese fail to explicitly disclose further comprising:

customizing the message text of one or more entries in the database for a particular insurance organization during an installation of the insurance claims processing program on a computer system.

Ertel teaches customizing the message text of one or more entries in the database for a particular insurance organization during an installation of the insurance claims processing program on a computer system (Ertel; column 13, lines 37-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system of Huffman, Kuwamoto, and Abbruzzese to include customizing the message text of one or more entries in the database for a particular insurance organization during an installation of the insurance claims processing program on a computer system, as taught by Ertel, with the motivation of managing the process of improving the quality and accuracy of reportable insurance claims data, allowing the analysis of claims data for the

purpose of identifying and correcting both case-specific and systematic problems in data quality in the most efficient way possible, making it possible to prioritize individual cases for in-depth review based upon user-defined criteria of importance, automatically routing relevant data quality messages to the appropriate recipient personnel, and providing a method and system to improve the accuracy, completeness, and overall quality of claims data (Ertel; column 5, lines 20-53).

(B) As per claims 11-12, 27-28, 41-42, 53-54, Huffman, Kuwamoto, Abbruzzese and Ertel teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 above, wherein the requested message text comprises information relevant to an estimate of a value of the insurance claim (Ertel; column 6, lines 37-39, column 10, lines 4-7, column 13, lines 5-9, column 15, lines 39-49, column 32, lines 18-21), and wherein the requested message code comprises an injury code which identifies a specific bodily injury or diagnosis, and wherein the requested message text comprises a name of the specific bodily injury or diagnosis (Ertel; column 11, lines 25-45, column 12, lines 4-19, 31-45, column 12, line 66 to column 13, line 9, column 25, lines 57-64, column 27, lines 5-7, column 35, lines 5-12).

(C) As per claims 13, 15, 29, 43, 45, 55, Huffman, Kuwamoto, Abbruzzese and Ertel teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 above, wherein the requested message code comprises a treatment or procedure code which identifies a specific injury treatment or procedure, and wherein the requested message text comprises a name of the specific injury treatment (Ertel; column 17, lines 25-49), and wherein

said displaying the matching message text corresponding to the requested message code comprises displaying the matching message text on a display device coupled to a computer system (Ertel; column 6, lines 9-22).

12. Claims 6, 22, 36, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, as applied to claims 1, 17, 31 and 47 above, and further in view of Winans, U.S. Patent Number 5, 307, 265.

(A) As per claims 6, 22, 36, 51, Huffman, Kuwamoto, and Abbruzzese teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 above.

Huffman, Kuwamoto, and Abbruzzese fail to explicitly disclose wherein the message text of one or more entries in the database is localized for use in a particular geographical location.

Winans teaches wherein the message text of one or more entries in the database is localized for use in a particular geographical location (Winans; Figures 4A, 4B, 5A, 5B, 6B, Items 10, 11, 12, 13, column 3, lines 11-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Huffman, Kuwamoto, and Abbruzzese to include wherein the message text of one or more entries in the database is localized for use in a particular geographical location, as taught by Winans, with the motivation of configuring each installation

to be sensitive only to the language needs of users entering the network at its local site, making it appear to each user in the network that every node in the network speaks his or her language--i.e. as though the entire network were a single system, and in this way optimizing the user-friendliness of the product for both end users and installations, and minimizing the amount of data that must be transmitted through the network to effect program-to-user communications (Winans; Abstract, column 2, lines 18-26).

13. Claims 7-8, 23-24, 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, as applied to claims 1, 17, 31 and 47 above, and further in view of McGauley, U.S. Patent Number 5, 899, 998.

(A) As per claims 7-8, 23-24, 37-38, Huffman, Kuwamoto, and Abbruzzese teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 above.

Huffman, Kuwamoto, and Abbruzzese fail to explicitly disclose wherein the database comprises a relational database, and wherein the database comprises an object-oriented database.

McGauley teaches wherein the database comprises a relational database (McGauley; Figure 6, Item 154, column 7, lines 7-14, 20-38) and wherein the database comprises an object-oriented database (McGauley; Figure 6, Item 152, Abstract, column 1, lines 29-35, column 7, lines 7-14, 20-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Huffman, Kuwamoto, and Abbruzzese to include wherein the database comprises a relational database, and wherein the database comprises an object-oriented database, as taught by McGauley, with the motivation of utilizing two types of databases in common use, both collections of data and software programs, to establish, route, organize, store and update information of a plurality of users (McGauley; column 1, lines 29-35).

14. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, and Ertel, U.S. Patent Number 5, 307, 262 as applied to claims 1 and 13 above, and further in view of Chen, et al, U.S. Patent Number 5, 504, 674.

(A) As per previously presented claim 59, Huffman, Kuwamoto, Abbruzzese and Ertel teach a method as analyzed and disclosed in claims 1 and 13 above.

Huffman, Kuwamoto, Abbruzzese and Ertel fail to explicitly disclose a method further comprising estimating a bodily injury general damages value based at least in part on the specific injury treatment.

However, the above features are well-known in the art, as evidenced by Chen.

In particular, Chen teaches a method further comprising estimating a bodily injury general damages value based at least in part on the specific injury treatment (Chen; see at least column 7, lines 20-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Huffman, Kuwamoto, Abbruzzese and Ertel to include further comprising estimating a bodily injury general damages value based at least in part on the specific injury treatment, as taught by Chen, with the motivations of determining an appropriate cost for repairing or replacing damaged objects, including personal body injuries while providing computer system for analyzing insurance claims and a method which integrates estimating insurance claims, providing insurance claim procedures, displaying text and displaying graphic images (Chen; column 1, lines 11-16, column 2, lines 56-59, column 7, lines 20-56).

Response to Arguments

15. Applicant's arguments filed 16 January 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 16 January 2004 and 15 March 2004.

(A) At page 13 of the 16 January 2004 response, Applicant apparently argues that a *prima facie* case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker,* 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges,* 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki,* 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart,* 531 F.2d 1048, 1052, 189 USPQ 143,147

(CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see papers number 6 and 9). Note, for example, the motivations explicitly stated at lines 9-13 of page 4 of the paper number 6 Office Action (i.e., " ...with the motivation of providing a method and a system of help-information control whereby ...") and at lines 8-14 of page 10 of the paper number 6 Office Action (i.e., " ...with the motivation of managing the process of improving the quality and accuracy of reportable insurance claims data ... ") and in the last paragraph of page 19 of this Office Action (i.e., "... with the motivations of determining an appropriate cost for repairing or replacing damaged objects, including personal body injuries...".

In response to Applicant's argument, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the

motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278 (CCPA) that:

(i) obvious does not require absolute predictability;

(ii) non-preferred embodiments of prior art must also be considered; and

(iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s)

which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art as discussed above, and Examiner has expressly articulated the combinations and the motivations for combinations as well as the scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention as discussed in paper number 6 and above, incorporated herein.

In response to Applicant's argument on pages 13-15 of the 16 January 2004 response that the applied references fail to teach the limitation "estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program wherein the insurance claim comprises a bodily injury claim", the Examiner respectfully disagrees and submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 6, section 7, pages 13-14) and above in the present Office Action. In particular, Examiner interprets the Abbruzzese teachings of an "estimated incurred loss field [... is ...] pre-filled" and "the clerk checks ... whether the bill is appropriate for the injury stated in the claim" to read on estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance

claim processing program, (Abbruzzese; column 43, lines 44-49, column 91, lines 41-45). Further, Examiner notes that the Chen reference teaches "a method for estimating insurance claims for damaged objects, with objects defined as an item or event involved in an insurance claim [... and which ...] may include parts of a person's body or injuries) (Chen; see at least column 7, lines 20-56).

In response to Applicant's argument on page 15 of the 16 January 2004 response that the applied references fail to teach customizing the message text of one or more entries in the database for a particular insurance organization, the Examiner respectfully disagrees and submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 6, section 4, pages 9-10) and above in the present Office Action. In particular, Examiner interprets the Ertel teachings of "any message may be selectively addressed to nurses... or physicians based upon the relevance of message content to the expertise of the recipient" and "[s]electively sorting the problems detected as to their seriousness or priority; ...[...]... generation of appropriate messages that describe both problems ...[...]... and their solutions in comprehensive terms; and ...[...]... [s]electively printing ...[...]... messages that are appropriate to the individuals responsible for resolving the problems" to read on customizing the message text of one or more entries in the database for a particular insurance organization (Ertel; column 6, lines 35-42, column 13, lines 37-45).

In response to Applicant's argument on page 16 of the 16 January 2004 response that the applied references fail to teach the limitations of claims 2, 3, and 5, the Examiner respectfully disagrees and submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 6, section 3, pages 8-9) and above in the

present Office Action. In particular, Examiner interprets the Kuwamoto teachings as shown in at least Figure 4, Figure 5, Figure 6 and Figure 10 illustrating the "initial loading program" (reads on during the installation of software), together with the Kuwamoto teachings of "... message identifier that identifies the help message keyed to the application program using that window ..." and "... initial loading program 1001 acquires, in step 1003, a help data storing position ...," as well as Kuwamoto's teachings of "every time integrated software comprising multiple APs [application programs] is loaded into an information processing system such as a word-processor, the storing position for the help message of each AP is placed in the help data management table located in a memory area common to all the APs. This arrangement makes it possible for the user to reference other help messages across different Aps," together with the Ertel reference, as discussed earlier, to read on specifying the message text of each entry in the database during an installation or initialization of the insurance claims processing program or application on a computer system and customizing the message text of one or more entries in the database for a particular insurance organization during an installation (Kuwamoto; column 3, lines 36-41, column 8, lines 28-35, column 9, lines 16-23), (Ertel; column 6, lines 35-42, column 13, lines 37-45).

In response to Applicant's argument on page 16 of the 16 January 2004 response that the applied references fail to teach the limitations of claims 12 and 13, the Examiner respectfully disagrees and submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 6, section 4, pages 10-11) and above in the present Office Action. In particular, Examiner interprets the Ertel teachings of "collection of files containing error conditions and trigger elements that cause data quality messages to be generated

for a given case. Specific conditions or combinations of conditions such as the following are included in these tables: [...] certain individual diagnosis or procedure codes ..." (Ertel; column 11, line 25 to column 13, line 45) to read on "wherein the requested message code comprises an injury code which identifies a specific bodily injury (or diagnosis)" and "wherein the requested message code comprises a treatment (or procedure) code which identifies a specific injury treatment (or procedure)."

Conclusion

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: **(703) 305-7687.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF." Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

May 20, 2004

Alexander Kalinowski
Alexander Kalinowski
Au 3626
Primary Examiner